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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,018	03/23/2004	Husnu M. Kalkanoglu	2003-116	2247
27569	7590	09/21/2007		
PAUL AND PAUL 2000 MARKET STREET SUITE 2900 PHILADELPHIA, PA 19103				
EXAMINER PARKER, FREDERICK JOHN				
ART UNIT		PAPER NUMBER		
1762				
NOTIFICATION DATE		DELIVERY MODE		
09/21/2007		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/807,018	KALKANOGLU ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Frederick J. Parker	1762	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 8-24-07 (RCE).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8-29-07 (2)</u> . | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8—24-07 has been entered.

### *Rule 105 Request*

2. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), *am* *9-17-07* additional information regarding this issue is required as follows: please indicate on the record the date when the method product was first commercially sold, as alluded to in the 1.132 Declaration, #20.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-7,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koscitzky US 5664385.

Koscitzky teaches making roofing shingles by applying a hot hardenable asphalt/ adhesive onto a longitudinally moving base sheet and then applying adjacent areas of colored granules onto the surface of the sheet (col. 3, 3-43). As recognized on col. 4, there are **gradational overlapping color transition zones** 36 between the (three) different colored areas 26 a-c, per claims 2,4,6, as shown in figure 2 and taught on col. 4, 27-42. Subsequently, slots 76 are formed in each of the transition intermediate areas 36 between colored areas where the two blend drops are intermixed in order to form a “sharp visual demarcation between adjacent colored areas” (emphasis added) (col. 5, 4-18), the intermediate areas 36 each having a width. (Note the goal of the reference is the same as that of Applicants, see page 2, 4<sup>th</sup> paragraph.) Col. 5, 34-38 notes the remaining region of the transition areas are not noticeable to the eye because of the slot. Figure 2 shows width differences between colored areas 26 a-c to provide varied aesthetics between colored areas.

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Koscitzky teach removing overlapping transition zone, **preferably** (but not limited to) those areas containing about 50:50 of 2 adjacent blend drops, to provide a clear line of demarcation between adjacent colored areas (see col. 5, 17-19). Column 5, line 4+ states slots 76 are located in all or substantially all of the transition areas 36 between adjacent colored areas; further col. 7, 3-9 teach slots 76 may vary in width and appearance, and hence the sharpness of transition zones will vary depending on desired visual aesthetics. There is no evidence presented by Applicants that completely removing the intermediate across its width provides any mechanical or other advantage not cited by the reference. Thus it is the Examiner's position that the reference provides at least the suggestion for complete removal when conditions so necessitate, and further note there is no limitation against doing so. Modifying the teachings of Koscitzky for strictly decorative or aesthetic purposes does not patentably distinguish over the prior art but rather would have simply been an obvious modification. Matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, *In re Seid* 73 USPQ 431.

Summarizing Koscitzky, it carries out the same process as Applicants, preferably on the centered areas having an approximate 50:50 ratio of overlapping granules. Koscitzky is not limited to this scenario, nor is the reference limited as to width size (e.g. col. 7, 3-8). The goal is to provide a clear line of demarcation between adjacent colored areas and wherein transition is not visually noticeable (col. 5, 34-37). Thus, removal of more than just the most visible part of the overlapping region is merely an obvious modification because the result would predictably have been an even less chance of the overlapping region from being visually noticed, which is the main goal of the teachings of Koscitzky. The combination of familiar elements according to

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known methods is generally obvious when it does no more than yield predictable results, KSR, 127 Sup. Ct. at 1739, 2007. Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Koscitzky by removing any or all of the width of the intermediate granule drop transition region as required by forming a slot to provide a desired ornamentation or aesthetic effect.

6. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koscitzky in view of the Admitted prior Art (APA), pages 1-2.

Koscitzky is cited for the same reasons previously discussed, which are incorporated herein. Applying second layers to make a laminated shingle is not cited.

The APA teaches it is known to form laminated shingles from two or more layers of shingle components. Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Koscitzky by forming multi-layer laminated shingles as the shingle type as disclosed by the APA prior to slotting intermediate areas to form laminated shingles with sharp visual demarcations between adjacent colored areas.

### ***Response to Arguments***

Applicants present the argument that the Examiner mis-interpreted “all” from Koscitzky to mean all of a transition area rather than all of the collective slot areas. Although the Examiner does not believe this is crucial, he has adjusted his rejection above to render Applicants’ arguments moot.

Applicants are incorrect in asserting Koscitzky teaches away from removing the entire intermediate area because 1) the 50:50 transition area to be removed is simply a preference, and

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2) the overall goal is to provide a clear line of demarcation between adjacent colored areas and wherein transition is not visually noticeable (same as Applicants). The obvious ultimate solution to the goal would be to remove the entire transition area, which is Applicants' specific solution, and it is the Examiner's position that this option is at least suggested or envisioned by the prior art. Applicants recite selected portions of the text of Koscitzky allegedly supporting their position but it is clear that simply removing all of the overlap region results in an obvious, predictable outcome well within the purview of one of ordinary skill, and the rejection as provided provides a prima facie case of obviousness. KSR 82 USPQ2d 1396 forecloses the argument that a specific teaching, suggestion, or motivation is required to establish a prima facie case of obviousness. KSR establishes that design incentives, market forces, predictability, use of ordinary skill and common sense, and ordinary capabilities or ingenuity of one skilled in the art articulated by the Examiner may be relied upon to support obviousness. Applicants cannot show any unexpected results or extraordinary ingenuity because the claims simply rely on the complete removal of a portion of a shingle which the prior art has already identified as being offensive aesthetically. Put another way, the prior art removes those offensive overlapping portions which are visually noticeable in use whereas the instant claims simply remove essentially all the overlapping portions. It is the Examiner's position this is an unpatentable and obvious variation of the recited prior art.

As to *In re Seid*, its reasoning is not "misplaced". The fact that it remains an essential part of the MPEP after 60 years (MPEP 2144.04I) attests to the fact that the courts after 60 years have not disagreed that aesthetic design changes are not patentable due to obviousness. While patents are regularly granted to shingles having design changes, they are granted because they disclose

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some degree of novelty or ingenuity rather than simply making obvious modifications of the known art.

Applicants state the slots perform functional features; slots in the shingle arts is well know, as is evident from Koscitzky. What is not in evidence is what unexpected or novel results are obtained by the removal of the entire width of the intermediate area display.

The Examiner has carefully considered the Declaration of Snyder. It appears Mr. Snyder has provided a well-written and concise summary of evolvement of aesthetic developments in the shingle arts, most of which were known to the Examiner. For example, Mr. Snyder points out developments in simulating natural shingles by changing granule coloration, thickness, etc. A summary of patentable changes directed to ornamentation effects/ providing “faux” appearances if you will, are provided: shingles simulating wood or tile; simulating / imitating structures or thickness variations; faux copper patinas; simulating thatched roofing when thatching is absent; simulating 3-dimensionality, shake shingles, snow drift appearance; etc, etc. The Examiner has no problem in these being inventive methods for forming unexpected appearances for roofing so the Examiner has no issue with the well-written summary. But such is not relevant to the instant case.

In the instant case, there is no unexpected faux simulation: no clouds, snowdrifts, faux thickness variations, simulated thatching, or any other unexpected or novel visual representation, only an obvious variation of what the prior art already teaches. No unexpected or significant outcome results from the claimed method. Thus there is little nexus between the issues regarding the rejection of the claims and the Declaration. And in fact the prior art only teaches the 50:50 ratio zone to be a preference; it is not limited to removing more if there are other portions which

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visually impair the product. Paragraph 14 of the Declaration is simply erroneous; the preferred portion is described in detail, but is clearly and simply a preference.

Paragraph 16 of the Declaration states the recited patents are not directed to the claimed subject matter. Mr. Snyder also opines from this summary that the instant claims are not obvious because they are not expressly taught in the prior art (#21). The reason may simply be that since the subject matter is obvious, it would have never been previously granted a patent.

The Examiner is acutely aware of the level of ordinary skill in the shingle art, as well as the qualifications of Mr. Koschitzky. The Examiner contends Mr. Koschitzky did envision the removal of any offensive amount of overlap, and simply preferred the 50:50 overlap regions because they were most visible.

Applicants have supplied some general information about supposed commercial success but have not supplied specific information regarding sales versus market and how the commercial success is derived from the advantages set forth in the specification. The meaning of the sales figures in context of total sales and other considerations (e.g. promotion/ advertising, market share, etc) are absent. Thus the statement alleging commercial success is inadequate.

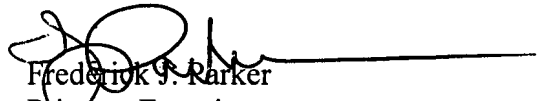
Mr. Snyder's Declaration, while being informative, is not persuasive and the rejections under 35 USC 103 are maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Frederick J. Parker  
Primary Examiner  
Art Unit 1762

fjp